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REMARKS

The Office Action dated October 18, 2006 contained a rejection of claims 1-16. The Applicant has amended independent claims 1, 7, 8, 9, 15, and 16. Claims 1-16 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over Howard (U.S. Patent Publication No. 2005/0091109) in view of Blaser (U.S. Patent No. 6,757,661).

The Applicant respectfully traverses this rejection based on the amendments to the claims and the arguments below.

The Applicant's claimed invention now includes sending the subscriber a list of publications related to any one or more that the subscriber already receives and a targeted content advertisement for the publication in which the targeted content advertisement is placed if it is determined that the subscriber is a low frequency user, as determined by the number of publications sent to the subscriber and the number of times the publications were sent from empirical data. Also, the subscriber is sent paid advertising and not sent additional on-line publications if it is determined from historical usage level data that the subscriber is a high frequency user.

First, the Examiner argued that Blaser disclosed the Applicant's "including recording times during the day that the subscriber requests files of the publications." However, the Applicant submits that Blaser does not disclose this feature. Instead, Blaser discloses at col. 6, lines 40-55 and col. 9, line 55 – line of col. 10 that the system tracks "data relating to usage and response to the advertisement, such as which user demographic categories have clicked-through the advertisement, the times of day of the click-throughs..." Although Blaser discloses tracking "times of day of the click-throughs," Blaser tracks displayed advertisements for performance evaluation purposes (see col. 9, line 55 – line of col. 10 of Blaser) and does not track detailed publication usage of the subscriber by recording times during the day that the subscriber requests files of the

publications like the Applicant's claimed invention.

In addition, although the combined references disclose a system for distributing customized publications, including customized advertising and customized content (see Abstract of Howard), increasing subscribers is a top priority (see Background) and ad server for selecting advertisements to be viewed by users of an online service based upon user activity (see col. 9 through col. 10 of Blaser), the combined references are still missing features of the Applicant's claimed invention. Namely, the combined references are missing the Applicant's newly added sending the subscriber a list of publications related to any one or more that the subscriber already receives and a targeted content advertisement for the publication in which the targeted content advertisement is placed if it is determined that the subscriber is a low frequency user, as determined by the number of publications sent to the subscriber and the number of times the publications were sent from empirical data and the subscriber is sent paid advertising and not sent additional on-line publications if it is determined from historical usage level data that the subscriber is a high frequency user.

In contrast, Blaser simply disclose a system that monitors user activity, compares the activity to identifiers in a targeted activity list, and displays targeted advertisements if the activity matches one of the identifiers (see col. 9 through col. 10 of Blaser). Blaser in combination with the other cited references, as argued above, are still missing the Applicant's claimed sending the subscriber a list of publications and a targeted content advertisement if the subscriber is a low frequency user, as determined by the number of publications sent and the number of times the publications were sent from empirical data and sending paid advertising and not sending additional on-line publications if the subscriber is a high frequency user.

Further, according to case law and the MPEP, all of the claimed elements of an Applicant's invention must be considered. If one of the elements of the Applicant's invention is missing from or not taught in the prior art and the Applicant's invention has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit Court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. In Re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988).

Although the Applicant agrees with the Examiner's statement that "Howard does not expressly teach that if the subscriber's usage level is determined to be above a first predetermined level ("high") sending the subscriber a targeted paid advertisement and if the subscriber's usage level is determined to be below a second predetermined threshold ("low") sending the subscriber a targeted content advertisement," the Applicant respectfully disagrees with the Examiner's next statement. In the next statement, the Examiner made an unsupported conclusion when he took "Official Notice" that the claimed features were "old and well known," without citing to a reference that discloses, teaches or suggests the features. Official Notice cannot be taken by an Examiner when a broad aspect is applied to detailed features of the claims, especially when the claims include several detailed features. If this were allowed, then the Examiner would effectively be taking knowledge and advantages from the Applicant's disclosure to reject the claims. It is well-settled in the law that the Examiner **cannot** use knowledge and advantages from the Applicant's disclosure to reject the claims. In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).

In addition, the Examiner **cannot** make conclusions regarding obviousness without providing an explanation for the teaching, disclosure or motivation to recreate the Applicant's invention. An Examiner's argument that does not include a reference that discloses, teaches, or suggests features of the claims (which is the case here where the Examiner attempted instead to take Official Notice of not one, but several features of the claims), but instead merely recites unsupported conclusions and uses boilerplate rejection language are a clear indication that **hindsight** was used by the Examiner, which is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

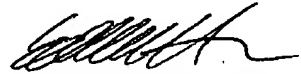
With regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on at least the same basis. (MPEP § 2143.03).

In view of the arguments and amendments set forth above, the Applicant respectfully submits that the rejected claims are in immediate condition for allowance. The Examiner is therefore respectfully requested to withdraw the outstanding claim

rejections and to pass this application to issue. Additionally, in an effort to expedite and further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (818) 885-1575. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
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